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10/761,099	01/21/2004	Hideo Miyake	Q79454	2438

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EXAMINER

SCHILLING, RICHARD L

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,099

Applicant(s)

MIYAKE ET AL.

Examiner

Richard L. Schilling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004 and 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-126 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-48 is/are allowed.
- 6) ☒ Claim(s) 49-75, 80-97 and 100-126 is/are rejected.
- 7) ☒ Claim(s) 76-79, 98 and 99 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/173,719.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 6,340,551 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

2. Claims 49-75, 80-91 and 100-126 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

Layer A compositions with the set forth polymers that are not copolymers with monomers a-1 to a-3 at mol% of at least 10% are new subject matter. There is no disclosure of materials for layer A in the original patent other than those comprising the said copolymers at amounts of at least 50% by wt. The patent states at col. 6, lines 6-20, that "It is necessary that the aqueous solution-soluble copolymer contains not less than 10% by mol of at least one of the above (a-1) to (a-3), as a copolymerization component". The copolymers of new claims 100-103 and 110 are new matter since the patent (col. 6, lines 20-68) discloses that the listed comonomers are only present as optional monomers in copolymers containing one of monomers a-1 to a-3. In regard to

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claims 100-126, materials without a compound that generates heat upon absorbing light in layer B contain new matter since the patent is limited to disclosing materials with compounds that generate heat by absorbing light in layer B even though layer A may also contain a heat generating light absorber. In regard to claim 110, layer B does not contain a heat generating light absorber since Ethyl Violet is disclosed as a coloring dye not as a heat generating dye. As stated in the patent (col. 16, line 66-col.17, line 1) it is necessary to add a light absorber that generates heat to layer B.

3. Claims 100-122 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application.

Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The original claims in the application resulting in the patent did not state that "said layer B being laminated directly on said layer A" as in patent claim 1. The above quoted requirement of direct lamination of B on A was added by amendment to overcome a prior art rejection over Damme et al. The rejection was withdrawn in view of above quoted added requirement since Damme et al. required an intermediate layer. See the Examiner's reason for allowance filed 8-30-01 in the patented file. Deleting a limitation to a claim added by amendment to overcome a rejection during the examination of the application for the patent is considered to be recapture of canceled subject matter. Materials with possible layers between layers A and B of the claims were surrendered subject matter during the prosecution of the original application. Reissue claims 100-122 entirely omit the above quoted limitation added to overcome a rejection and, thus, are impermissible recapture even if the reissue claims include other limitations making the reissue narrower in other aspects from the patent claims. In regard to claims 111 and 119, the coating of layer B is not is not required to be "directly" on layer A. In regard to reissue claims 104-110 and 115-118, the term "in order" does not exclude intermediate layers. See MPEP 1412.02.

4. Claims 90 and 91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is indefinite as to whether or not applicants intend the dyes of claim 90 to decompose since they are coloring dyes not listed as decomposable compounds in the specification.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 92-97 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to show one skilled in the art how to make and use negative materials set forth in the instant claims without crosslinking agents that crosslink in the presence of an acid. The need for the said crosslinker for negative material is disclosed in the patent on col. 13, lines 24-27.

6. Claims 49-75, 80-91 and 100-126 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter not described in the written description in the specification is identified as new matter in paragraph 2 above.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 49, 50, 53-55, 80-82, 85-88, 100, 101, 111, 112, 115, 116, 119, 120, 123 and 124 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Damme et al. '502. Van Damme et al. (see particularly col. 2, line 22-col. 3, line 10; col. 4, lines 1-12; col. 5, lines 37-57; col. 6, lines 1-6) disclose materials with supports, photosensitive layers with alkali soluble polymers and, laminated thereon, intermediate layers with IR absorbing dyes and alkali soluble polymers, including polyvinyl phenols, meeting the requirement of alkali soluble phenol polymer containing layers with light absorbers laminated directly on layers with alkali soluble polymers set forth in the instant reissue claims. Also, the elements in Van Damme et al. comprise thermosensitive layers with light absorbers and alkali soluble resins, including novolaks, laminated directly on the intermediate layers with alkali soluble polymers and light absorbers. In regard to instant claims 50, 111 and 119, the solvents are not necessarily present in the claimed coated materials. In regard to claim 100, the intermediate layers include methacrylic acid copolymers.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 51, 52, 56-76, 83, 84,90, 91, 102-105, 110, 113,117, 118, 121,125 and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Damme et al. '502 in view of Kawamura et al. '123 and Parsons et al. Van Damme et al (col. 6, lines 1-6) disclose materials with layers within the scope of layers A and B of the claims as explained in paragraph 7 above with dyes as visible coloring agents and dyes as IR absorbers but do not disclose the particular coloring dyes or IR absorbing dyes set forth in the instant claims. Kawamura et al. (col. 34, lines 4-11) and Parsons et al. (see particularly col. 5, line 56-col. 6, line 57; col. 9, lines 1-52; example 31) disclose thermosensitive materials with commercially available coloring dyes as set forth in instant claims 51, 52,56,57,83,84,90,91,102,103,113, 117, 118, 121, 125 and 126. Parsons et al also disclose that preferred IR absorbing dyes for converting light into heat include the cyanine dyes of instant claims 58-76, 104, 105 and 110. Since Van Damme et al. disclose the use of visible dyes for coloring their images, it would be obvious to one skilled in art to use commercially available coloring dyes, such as set forth in Parsons et al. and Kawamura et al., as the called for coloring dyes in Van Damme et al. It would also be obvious to one skilled in the art to use the preferred cyanine dyes of Parsons et al. as the called for IR absorbing dyes in Van Damme et al. Kawamura et al. is available as a reference under 35 USC 102, paragraphs a, e and b, since reissue claims 49-75, 80-91 and 100-126 are not entitled to priority under 35 USC 120 or 119, since the original patent, parent application 09/173,719 and the foreign priority documents do not disclose, within the meaning of the first paragraph of 35 USC 112, the subject matter identified as new matter in paragraph 2 above.

9. Claims 49, 50, 53, 54, 58-61 and 64-67 are rejected under 35 U.S.C. 102(e) as being anticipated by West et al. '222. West et al. (see particularly col. 3, lines 42-60; col. 6, lines 12-67; col. 5, lines 1-60; example 1) disclose materials with thermosensitive layers of phenolic resins, dissolution inhibitors and cyanine IR absorbing dyes directly laminated on subbing layers with alkali soluble polymer.

10. Claims 49- 75, 85-91, 104-109, 111-114 and 119-126 are rejected under 35 U.S.C. 102(e) as being anticipated by Parsons et al. Parsons et al. (see particularly col. 5, line 56- col. 6, line 57; col. 9, lines 19-52; col. 10, lines 4-68; example 31) disclose materials with top layers comprising phenolic resins, insolubilisers and cyanine IR absorbing dyes directly laminated on undercoats with alkali soluble polymers and IR absorbers.

11. Claims 76-79, 97 and 98 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1-48 are allowed. Claims 1-48 and 76-79 are within the scope of the patent claims. Claims 97 and 98 are fully supported by the patent disclosure. The amendments to the specification are obvious corrections.

12.. The prior art cited in the patent and in its parent application has been considered. Miyake et al. and Kawauchi et al. '795 are cited of interest as disclosing recording materials with two recording layers with alkali soluble resins. Sheriff et al. and West et al. '532 are cited of interest as being similar to West et al. '222. Burberry et al. is cited of interest as disclosing cyanine IR absorbing dyes as set forth in

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the instant claims.

Any inquiry concerning this communication should be directed to Richard L. Schilling at telephone number 571-272-1335.

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GROUP 4100 1752

Richard L. Schilling